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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/255,297	02/22/99	STOUTENBOROUGH	E 70165-164

WALTER E ZIMMERMAN
FOLEY & LARDNER
FIRSTAR CENTER
777 EAST WISCONSIN AVENUE
MILWAUKEE WI 53202-5367

PM92/0204

EXAMINER

WALSH, J

ART UNIT PAPER NUMBER

3627

DATE MAILED:

02/04/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/255,297

Applicant(s)

STOUTENBOROUGH ET AL.

Examiner

John B. Walsh

Art Unit

3627

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- 1) ☐ Responsive to communication(s) filed on 22 November 1999.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-92 is/are pending in the application.
- 4a) Of the above claim(s) 87-89 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12-86 and 90-92 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some * c) ☐ None of the CERTIFIED copies of the priority documents have been:
1. ☐ received.
 2. ☐ received in Application No. (Series Code / Serial Number) _____.
 3. ☐ received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. & 119(e).

Attachment(s)

- 14) ☒ Notice of References Cited (PTO-892) 17) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 15) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 18) ☐ Notice of Informal Patent Application (PTO-152)
- 16) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 8. 19) ☐ Other: _____

Art Unit: 3627

DETAILED ACTION

Drawings

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the hook member must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-6, 12-27, 36, 49-78, 81-86, 90 and 91 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites "a first position to a second position" on line 7. Applicant recited "a first position and a second position" earlier in line 5. After the first occurrence of these terms the applicant should refer to them using either "said first position" or "the first position" in order to avoid any confusion that the applicant is not claiming another "first and second position".

Claim 15 recites the limitation "a latch". It is unclear if applicant is claiming another latch or referring to the prior claimed latch.

Claims 20 and 41 recite the limitation "the first lock member". There is insufficient antecedent basis for this limitation in the claims.

Claim 22 recites the limitation "the secondary lock member". There is insufficient antecedent basis for this limitation in the claim.

Art Unit: 3627

Claim 26 recites the limitation "a activation device". Applicant should rewrite the claim to read "the activation device".

Claim 36 recites the limitation "the orientation of the latch may be reversed." The use of the term "may be" is indefinite since it does not set forth the metes and bounds of the patent protection desired.

Claims 49, 63, 81, 85, 90 and 91 recite "shaped to be inserted". This limitation is indefinite and unclear.

There is an inconsistency between the language in the preamble and certain portions in the body of the claim, thereby making the scope of the claim unclear. The preamble in claims 63, 81, 85 and 90 clearly indicates that a subcombination is being claimed, e.g., "a lock assembly for securing a door...." This language would lead the examiner to believe that the applicant intends to claim only the subcombination of "a lock assembly," the door being only functionally recited. This presents no problem as long as the body of the claim also refers to the door functionally, such as, "for attachment to said door."

The problem arises when the door is positively recited within the body of the claim, such as, "the latch aperture being located along the first edge of the door." There is an inconsistency within the claim; the preamble indicates subcombination, while in at least one instance in the body of the claim there is a positive recital of structure indicating that the combination of a lock assembly and a door is being claimed. The examiner cannot be sure if applicant's intent is to claim merely the lock assembly or the lock assembly in combination with the door.

Applicant is required to clarify what the claims are intended to be drawn to, i.e., either the lock assembly alone or the combination of the lock assembly and the door. Applicant should

Art Unit: 3627

make the language of the claim consistent with applicant's intent. In formulating a rejection on the merits, the examiner is considering that the claims are drawn to the combination and the claims will be rejected accordingly. If applicant indicates by amendment that the combination claim is the intention, the language in the preamble should be made consistent with the language in the body of the claims. If the intent is to claim the subcombination, then the body of the claims must be amended to remove positive recitation of the combination.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. As best understood claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. Re. 26,677 to Russell et al.

Russell et al. '677 teaches a base lock member (16); a first input device (49); and an activation device (20).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. As best understood claims 2-6, 12-35, 37-49, 51-53, 55-68, 70, 72-78, 81-86 and 90-92 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. Re. 26,677 to

Art Unit: 3627

Russell et al. as applied to claim 1 above and further in view of U.S. Patent No. 5,498,038 to Simon et al.

Russell et al. '677 teaches a housing (11); a latch (18); a second input device (85) provides a positive indication to an operator; said first input device is a thumbturn (49); said second input device is a handle (85); said activation device is a button (20); said first input device is a handle (49); the activation device is removable (with proper tools is removable); the second input device is prevented from rotation in one direction (column 4, lines 12-15); a motion reversing mechanism (105); a deadbolt aperture (figure 4); a drive (54); and a lock out means (20).

Simon et al. '038 teaches at least one secondary locking member (figure 11; 223 (top)); said at least one secondary lock member is an extension bolt (223); a first lock member (figure 11; 223 (bottom)); a first extension member base (figure 11, top of 110); a second extension member base (figure 11, bottom of 110); a first extension member aperture (229); a second extension aperture (229); a first extension member (221); a second extension member (figure 11, 221); a first edge plate (figure 11, plate for 223); a second edge plate (figure 11, plate for 223).

As concerns the limitations of the second input device must be rotated less than forty five degrees and wherein the at least one second lock member and the first lock member each move linearly at least one inch, it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide these modifications, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. In re Aller, 105 USPQ 233.

Art Unit: 3627

As concerns the limitations of said at least one secondary lock member is a deadbolt, the base lock member is a hook member and the at least one secondary lock member is a hook member is seen as an obvious design choice. It is well known in the art to use either a deadbolt or a hook member for bolting.

It would have been obvious to one skilled in the art at the time the invention was made to modify the latch arrangement of Russell et al. '677 with secondary lock members, as taught by Simon et al. '038, in order to provide auxiliary locking members to enhance security.

8. As best understood claims 36, 50, 54, 69 and 71 rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. Re. 26,677 to Russell et al. in view of U.S. Patent No. 5,498,038 to Simon et al. as applied above and further in view of U.S. Patent No. 4,671,549 to Marotto et al.

Marotto et al. '549 teaches the orientation of a latch that is adapted to be reversed (abstract). It would have been obvious to one skilled in the art at the time the invention was made to modify the latch of Russell et al. '677 as modified for use on either right or left handed doors as taught by, Marotto et al. '549, in order to provide a latch arrangement that is more versatile.

9. As best understood claim 77 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. Re. 26,677 to Russell et al. in view of U.S. Patent No. 5,498,038 to Simon et al. as applied above and further in view U.S. Patent No. 5,192,097 to Su.

Su '097 teaches a latch is substantially made of a polyester resin (abstract). It would have been obvious to one skilled in the art at the time the invention was made to modify the latch of

Art Unit: 3627

Russell et al. '677 as modified with a plastic latch as taught by Su '097, in order to provide a latch arrangement that is corrosion resistant.

10. Claims 7-11, 79 and 80 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. Re. 26,677 to Russell et al. in view of U.S. Patent No. 5,498,038 to Simon et al. as applied above and further in view of U.S. Patent No. 2,218,183 to Springer.

Springer '183 teaches a passive lock device including a passive lock member (24) moves in response to the base lock member; a passive input device (73)
A second door including a passive lock (page 2, lines 27-29); and an extension member (26).

It would have been obvious to one skilled in the art at the time the invention was made to modify latch of Russell et al. '677 as modified with a passive lock system, as taught by Springer '183, in order to provide a keeper that is more secure at latching a bolt, hence adding a greater element of security.

Election/Restrictions

11. Applicant's election with traverse of Group III (claims 87, 88) and Group IV (claim 89) in Paper No. 7 is acknowledged. The traversal is on the ground(s) that the process cannot be practiced by another materially different apparatus. This is not found persuasive because a materially different apparatus having an activation device (button) is capable of practicing the claimed process. The requirement is still deemed proper and is therefore made FINAL.

The applicant's arguments with respect to Group II (claims 7-11, 79 and 80) are found persuasive.

Art Unit: 3627

12. Claims 87-89 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim.

Applicant timely traversed the restriction (election) requirement in Paper No. 7.

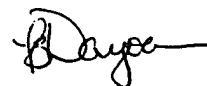
Conclusion

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to John B. Walsh whose telephone number is 703-305-0444. The examiner can normally be reached on Monday-Friday from 8:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, BethAnne Dayoan can be reached on 703-308-3865. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-3597 for regular communications and 703-305-3597 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-2168.



JW
January 31, 2000

B. DAYOAN
PRIMARY EXAMINER
GROUP 3200
3620